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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,658	08/30/2001	Carol Lee Hobson	40655.4400	3216

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EXAMINER
HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 04/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/943,658	HOBSON ET AL.
	Examiner	Art Unit	
	Calvin L Hewitt II	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>03 February 2005</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is

closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>*18-25 and 35-37*</u> is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) <u>*18-25 and 35-37*</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All   b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage

application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

Status of Claims

1.   Claims 18-25 and 35-37 have been examined.

Response to Amendment

2.   In order to address the 112 rejection, Applicant directs the Examiner to the Applicant's Disclosure for specific instances and explanation of an "authenticated channel". However, the Examiner is not challenging the existence of the "authenticated channel". But in the context of the claims (18, 23 and 35), the "-ed" implies that the channel has gone through a prior authentication process, hence one of ordinary skill would expect a method step detailing the process by which the channel became "authenticated".

        Claim 18 has been amended to include the language "... for use by said merchant in submitting a payment request based on said second secondary transaction number". Claim 35 recites similar language. However, this is "intended use" (MPEP 2114 and Ex parte Masham, 2 USPQ2nd 1647 (1987)) and does not distinguish the claim from the prior art.

        Claim 23 has been amended to include the language of authenticating users, "based on data extracted from a payment instrument by said

authentication device". However, this is taught by the prior art of Gifford (column 8, lines 1-7 and 24-31; column 10, lines 50-67).

Regarding "a signed challenge string and a digital certificate" (claims 22 and 35), the Examiner maintains the applied 112 rejections and for purposes of Examination they will continue to be regarded as non-distinct.

The Examiner maintains the rejection to claims 18-25. Claims 35-37 are also treated below.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4.   Claims 35-37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 35 recites, "comparing said signed challenge string and said digital certificate". Applicant argues that the Specification supports a signed challenge string and a digital certificate as distinct data (paragraphs 12, 34, 35, 54 and 57).

However, this contradicts the clear teachings of paragraph 54, where Applicant

equates the two, or at least requires one be an instance of the other (A signed

challenge string (e.g., digital certificate)). The Specification is also silent

regarding some sort of comparison (paragraphs 12, 34, 35, 54 and 57).

Therefore, to one of ordinary skill the Specification is unclear as to the exact

relationship between the certificate and the signed challenge string.

Claims 36 and 37 are also rejected as they depend from claim 35.

5.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly
claiming the subject matter which the applicant regards as his invention.

6.   Claims 18-25 and 35-37 are rejected under 35 U.S.C. 112, second

paragraph, as being indefinite for failing to particularly point out and distinctly

claim the subject matter which applicant regards as the invention.

        a.   Claims 18, 23 and 35 recite communicating over "an *authenticated*

communication channel". To one of ordinary skill, this is an indication that steps

were taken to authenticate the channel. However, the preceding limitations are

silent regarding such an action or actions. Claim 35 also recites "a user request

to facilitate a merchant with said merchant". To one of ordinary skill this reads on

a *merchant A* sending a user request to facilitate a transaction with *merchant A.*

Similarly, claim 35, recites "retrieving from said merchant..." To one of ordinary

skill, it is not clear if an "unclaimed" third party is involved, or as in the case of the

"retrieving" step, the challenge string and certificate is retrieved by the user, for example.

Claims 19-22, 24, 25, 36, and 37 are also rejected as they depend from claims 18, 23 or 35.

Claim 35 also recites, "comparing said signed challenge string and said digital certificate". Applicant argues that the challenge string and digital certificate are distinct data (paragraphs 12, 34, 35, 54 and 57). However, this contradicts the clear teachings of paragraph 54, where Applicant equates the two, or at least requires one be an instance of the other (A signed challenge string (e.g., digital certificate)). While, the Applicant provides multiple embodiments, this refers only to the configuration of the system such as a merchant maintaining control of a user's browser (paragraph [0054]) and not to the data exchanged. The Specification is also silent regarding some sort of comparison, therefore in order to be considered distinct, the claim should include language such as, "not one in the same" or "different".

Claims 36 and 37 are also rejected as they depend from claim 35.

7.   Claims 18, 23 and 35 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted

steps are: creating an authenticated channel (Specification, page/line 21/22-22/5).

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9.   Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Payne et al., U.S. Patent No. 5,715,314 in view of Purpura, U.S. Patent No. 6,421,768.

As per claims 18-20, Payne et al. teach an online transaction system comprising:

- receiving at a host website (payment computer) an HTTP request from a user browser (column 5, lines 25-30; column/line 9/50-10/20)

- sending said user a challenge string (column 6, lines 30-42) and authenticating said user by receiving authentication information from said user wherein the information corresponds to the user account (column 6, lines 30-59)

- generating a secondary transaction number associated with a user account and using the number to facilitate a transaction between merchant and user (column 7, lines 22-30)

- establishing an authenticated communication channel between the host and a merchant (column 7, lines 30-40)

Payne et al. also teach communicating [claims 23-25] with a user over a distributed network (figure 1), recognizing the presence of an authentication device on a user's computer system (figures 1, 4, 7 and 8; column 4, lines 35-37; column 7, lines 31-39; column 8, lines 33-38) and receiving account information from a host system to facilitate a transaction between merchant and user (column 7, lines 22-30). Payne et al. do not specifically recite a merchant redirecting a user to a host site. Purpura provides a general teaching for redirecting a user from a one computer to another over the internet (column 4, lines 46-48 and 50-55). Purpura also discloses standard techniques for establishing an "authenticated" channel between computers. For example, Purpura discloses basic key or token exchange protocols (e.g. Interlock Protocol) where a receiving party confirms the origination of a sent token (e.g. key) (column 4, lines 7-16). More integral to Purpura's invention, however, is an authentication protocol using basic "redirection". Specifically, Purpura teaches a first computer depositing a host system signature in a user browser and a second

computer decrypting the signature to authenticate the first computer or host

system (column/line 3/60-4/6). Therefore, it would have been obvious to one of

ordinary skill to combine the teachings of Payne et al. and Purpura in order to

allow a user authenticated on a first computer (e.g. via password- '768, column 3,

lines 15-36; '314, figure 7) to be securely authenticated on a second site without

having the user re-authenticate her/himself ('768, column 3, lines 38-43).

10.   Claims 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Payne et al., U.S. Patent No. 5,715,314 and Purpura, U.S. Patent No.

6,421,768 as applied to claim 21 above, and further in view of Gifford, U.S.

Patent No. 5,724,424.

As per claims 21-25, Payne et al. teach a secure online transaction

system between user, merchant and host comprising password strings,

authenticated channels, and transaction numbers (abstract; figure 1; column 5,

lines 25-30; column 7, lines 20-40; column/line 9/50-10/20). Purpura provides a

general teaching for redirecting a user from a one computer to another over the

internet (column 4, lines 46-48 and 50-55). Purpura also discloses standard

techniques for establishing an "authenticated" channel between computers

(column 4, lines 7-16). Purpura provides a general teaching for redirecting a user

from a one computer to another over the internet (column 4, lines 46-48 and 50-

55). Purpura also discloses standard techniques for establishing an

"authenticated" channel between computers. For example, Purpura discloses

basic key or token exchange protocols (e.g. Interlock Protocol) where a receiving

party confirms the origination of a sent token (e.g. key) (column 4, lines 7-16).

More integral to Purpura's invention, however, is an authentication protocol using

basic "redirection". Specifically, Purpura teaches a first computer depositing a

host system signature in a user browser and a second computer decrypting the

signature to authenticate the first computer or host system (column/line 3/60-4/6).

However, neither Payne et al. nor Purpura explicitly recite smart cards. Gifford

teaches entering a personal identification number and inserting a smart card into

a smart card reader (figure 4; column/line 10/54-11/8). The Gifford system

authenticates users by receiving user authentication information such as a

signed challenge string (e.g. digital certificate) (column 10, lines 30-53). Gifford

also authenticates users based on data extracted from a payment instrument by

said authentication device (column 8, lines 1-7 and 24-31; column 10, lines 50-

67). Therefore, it would have been obvious to one of ordinary skill to combine the

teachings of Payne et al., Purpura and Gifford in order more securely convey

private data ('314, figure 2E, items 77 and 79; column 6, lines 30-59; '424,

column/line 10/54-11/8).

11.   Claims 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Payne et al., U.S. Patent No. 5,715,314 in view of Gifford, U.S. Patent No.

5,724,424.

As per claims 35-37, Payne et al. teach an online transaction system

comprising:

- receiving at a host website (payment computer) an HTTP request

  from a user browser (column 5, lines 25-30; column/line 9/50-

  10/20)

- sending said user a challenge string (column 6, lines 30-42) and

  authenticating said user by receiving authentication information

  from said user wherein the information corresponds to the user

  account (column 6, lines 30-59)

- generating a secondary transaction number associated with a user

  account and using the number to facilitate a transaction between

  merchant and user (column 7, lines 22-30)

- establishing an authenticated communication channel between the

  host and a merchant (column 7, lines 30-40)

Payne et al. also teach communicating [claims 23-25] with a user over a

distributed network (figure 1), recognizing the presence of an authentication

device on a user's computer system (figures 1, 4, 7 and 8; column 4, lines 35-37;

column 7, lines 31-39; column 8, lines 33-38) and receiving account information

from a host system to facilitate a transaction between merchant and user

(column 7, lines 22-30). However, Payne et al. do not specifically recite retrieving

from a merchant a signed challenge string and a digital certificate. Gifford

teaches entering a personal identification number and inserting a smart card into

a smart card reader (figure 4; column/line 10/54-11/8). Gifford also teaches

authenticating users by receiving user authentication information such as a

signed challenge string (e.g. digital certificate) (column 10, lines 30-53) and

settlement using account numbers (figure 4; column 8,lines 17-20; column 10,

lines 9-20). Therefore, it would have been obvious to one of ordinary skill to

combine the teachings of Payne et al., and Gifford in order more securely convey

private data ('314, figure 2E, items 77 and 79; column 6, lines 30-59; '424,

column/line 10/54-11/8).

Conclusion

12.   Applicant's amendment necessitated the new ground(s) of rejection

presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**.

See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as

set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire

THREE MONTHS from the mailing date of this action. In the event a first reply is

filed within TWO MONTHS of the mailing date of this final action and the advisory

action is not mailed until after the end of the THREE-MONTH shortened statutory

period, then the shortened statutory period will expire on the date the advisory

action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

calculated from the mailing date of the advisory action. In no event, however, will

the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

13.   Any inquiry concerning this communication or earlier communications from

the Examiner should be directed to Calvin Loyd Hewitt II whose telephone

number is (571) 272-6709. The Examiner can normally be reached on Monday-

Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the

Examiner's supervisor, James P. Trammell, can be reached at (571) 272-6712.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

c/o Technology Center 2100

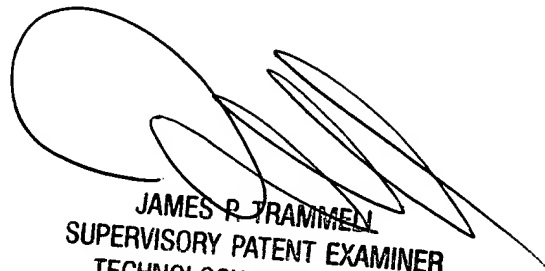Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and

after-final communications),

or:

       (571) 273-6709 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Calvin Loyd Hewitt II

April 25, 2005

JAMES P TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600